



AF/2164

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Lawrence M. Ausubel

Serial No.: 09/476,877

Filed: January 3, 2000

For: Computer Implemented
Methods and Apparatus for
Auctions

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Art Unit: 2164

Examiner: Poinvil, F.

Atty Docket: 21736/0010

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APPELLANT'S REPLY BRIEF

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is Appellant's Reply Brief in response to the Examiner's Answer of December 21, 2001.

Appellant submits this Reply Brief in order to respond to three aspects of the Examiner's Answer. Each aspect is new to the prosecution.

In particular, for the first time in the prosecution of this application, the Examiner interprets the reference of record to suggest that an auction "may end after an elapsed time period or after a number of items have been sold based on monetary value." In this and the following portions of the text the Examiner's Answer attempts to justify the rejection. As Appellant will point out below, even this new aspect of the rejection fails to meet the thrust of the claimed subject matter.

The Examiner's Answer suggests that all rejected claims stand or fall together based on the erroneous allegation that the Brief "does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof." As

will be described below, Appellant's Brief does concisely segregate the claims, provide reasons therefor and arguments specific to each of the different sets of claims.

Finally, the Examiner's Answer erroneously alleges that the claimed "decision means" is recited as responding to "related bid information" where the "bid related information" is not positively defined. As Appellant points out below, the decision means of claim 53, the step of determining (in claims 60, 74 and 84) and the means for determining (in claims 67 and 81) are expressly recited as responding to either "bid information", or "signals" which are based on "bid information" or on "bids". There is no merit to the suggestion that any aspect of the claim is "not positively defined" and each aspect patentably defines over the sole reference.

The New Thoughts in the Examiner's Answer do not Justify the Rejection

Appellant's Brief argued that claims 53 and 60 distinguish from the art by calling for "decision means responsive to the bid information received from the user's systems for determining whether an auction should continue or terminate" (claim 53) and "determining at the auctioneer's system, in response to the bid information received from users, whether the auction should continue or terminate" (claim 60).

Throughout the prosecution the Appellant took the position that the ONSALE publication (the sole reference relied on) mentioned selling merchandise in either "a standard auction" or a "dutch auction". The reference did not describe any "decision means responsive to the bid information received from the user's systems for determining whether an auction should continue or terminate" (as recited in claim 53) or a step of "determining at the auctioneer's system, in response to the bid information received from users, whether the auction should continue or terminate" (as recited in claim 60).

For the first time in this prosecution the rejection is justified in the Answer on the basis that:

“As in most auction systems, an auctioneer usually determines or announces the time of start/end of an auction based on many criteria. An auction may end after an elapsed time period or after a number of items have been sold based on monetary value. When these criteria have been set or have been reached, sending a message to bidders would have been obvious to one of ordinary skill in the art in order to inform them of the end of the auction and not to transmit any new or more bids. Thus, the decision means including means for initiating a non-final message to continue the auction and a final message to terminate the auction would have been based, depending on the status of these criteria.” (Examiner’s Answer, pages 3-4.)

This speculation (from the Examiner’s Answer, pages 3-4) suggests that an auction may end after an elapsed time or after a number of items have been sold. Even the speculation, however, does not address the claimed decision means which operates based on “the bid information” or the claimed step of determining which responds to “the bid information”. Rather, the speculation suggests the claimed subject matter is unnecessary on the basis that an auction which terminates “after an elapsed time period”, does not require a computer system or method to include a “decision means responsive to the bid information received from the user’s systems for determining whether an auction should continue or terminate” (as recited in claim 53) or a step of “determining at the auctioneer’s system, in response to the bid information received from users, whether the auction should continue or terminate” (as recited in claim 60). Thus, the new thoughts in the Answer do not even argue that the reference describes the claimed subject matter.

The remainder of the speculation that “An auction may end ... after a number of items have been sold based on monetary value” is hopelessly circular, self-referential and also fails to justify the maintenance of the rejection in light of the omissions of the disclosure of the reference. The usual notion of an item being “sold” in an auction typically requires the auction to “end” for that item. The usual notion of “monetary value” for an item in an auction is the price for the item when the auction ends. So it is unclear what is meant by the auction ending “after items have been sold” or “based on monetary value”. It is the ending of the auction that determines the sale of the item or the monetary value associated with the item in the auction. In short, the reasoning of the Final rejection does not justify the rejection and the Answer also fails to supply a

rationale for the rejection. Appellant submits there is no basis for maintaining the rejection in light of failure of the reference to teach, describe or even hint at the claimed subject matter.

Each of the rejected claims is directed to auctions of "television licenses or associated derivative rights". The important characteristic of these items is that they are dissimilar, see p. 12 of Appellant's Brief. The specification makes it clear that auctions of dissimilar but related items are more difficult than auctions in general:

"In another aspect, the invention relates to an implementation of an **efficient auction for multiple dissimilar objects** and to an implementation of a generalized English auction for multiple dissimilar objects. These types of auctions **are more difficult to implement in that, because the objects are dissimilar and hence must be treated individually, significantly more information is required to be input and processed than in an auction for similar objects.**" (page 6, lines 6-11, emphasis added)

The specification continues and describes how the invention maintains the auction so as to continue to receive bids until no further information is required to achieve an efficient result:

"This aspect of the invention describes implementations of new ascending-bid auctions for **selling multiple, dissimilar objects**, which have the analogous advantage of conserving on the revelation of high-bidders' values. It beginsbut transforms it into a progressive procedure which stops eliciting information **the moment that no further information is needed to determine the efficient allocation.**" (page 7, lines 16-21, emphasis added)

The specification emphasizes:

"This application presents two specific procedures for extracting this information in a sequential fashion. The **efficient auction procedure is guaranteed to terminate in finite time, and at an efficient allocation of the objects being auctioned.**" (page 8, lines 11-14, emphasis added)

Two procedures are illustrated in figs. 8 and 9 of the application. It is readily apparent that there is no connection between this subject matter and

auctions which terminate “after an elapsed time period or after a number of items have been sold based on monetary value”. (Examiner’s Answer, p. 4).

Clearly, the termination of auctions which terminate “after an elapsed time period” is **not** based on “bid information” since it is expressly based on time. The basis for the termination of auctions which terminate “after a number of items have been sold based on monetary value” is too speculative to be of any value in determining patentability.

Whereas claims 53 and 60 relate to determining whether the auction should continue or terminate, claims 67 and 74 relate to assigning “the television licenses or associated derivative rights” to the bidders. In a similar fashion claims 81 and 84 relate to allocating “the television licenses or associated derivative rights to bidders”. Since the subject matter being auctioned cannot be allocated or assigned until the auction has been concluded, claims 67, 74, 81 and 84 distinguish from the reference for the same reasons given with respect to claims 53 and 60.

The Claims are Properly Grouped and Argued in the Brief

The Examiner’s Answer, at page 2, alleges that the rejected claims “stand or fall together because the Appellant’s Brief does not include a statement that this grouping of claims does not stand or fall together, and reasons in support thereof”.

To the contrary, the Brief has a heading “Grouping of Claims” (see page 5). Under this heading, Appellant indicates that the Brief will discuss a first group of claims (independent claims 53 and 60 and dependent claims 57 and 64), a second group of claims (independent claims 67, 74, 81 and 84 and dependent claims 71, 78, 82 and 85), a third group of claims (dependent claims 54, 61, 65, 68, 75 and 83) and finally the patentability of claim 66 will also be separately addressed. The summary succinctly points out (see page 14) how the claims differ from each other and each group of claims is separately argued. In particular, the patentability of claims 53, 57, 60 and 64 is argued

at pages 6-9, the patentability of claims 67, 71, 74, 78, 81, 82, 84 and 85 is argued at pages 9-12, the patentability of claims 54, 61, 65, 75, 83 and 86 is argued at pages 12-13 and the patentability of claim 66 is argued at pages 13-14.

Accordingly, appellant submits that the claims are separately argued and should be considered as argued.

The Claims are not Indefinite

Page 5 of the Examiner's Answer erroneously argues that the claimed decision means is recited as responsive to "related bid information" and argues that the 'bid related information' in the independent claims is "not positively defined as to what they are or what they intend to be."

In fact, a simple reference to claim 53 shows that the decision means is recited as being "responsive to the bid information". Reference to claim 60 reveals that the determining step is specifically recited to be "in response to the bid information". In claim 67 the means for determining is recited as being "based on the signals" which in turn are "based on the bid information". A similar recitation of determining based on signals and signals based on bid information is found in claim 74. In claim 81 the means for determining is recited as being "based on the bids" and in claims 84 the step of determining is recited at "based on the bids".

Thus Appellant suggests that to the extent the Answer alleges that the "decision means" operates "in response to "related bid information" where the "phrase 'bid related information' in the independent claims are not positively defined" it is simply wrong.

For the foregoing reasons, Appellant requests reversal of each and every rejection and allowance of the application.

Respectfully submitted,

A handwritten signature in cursive script, reading "Stanley B. Green". The signature is written in dark ink and is positioned above the printed contact information.

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